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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/583,600

06/19/2006

Hiroaki Torii

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32172 7590 05/26/2010

DICKSTEIN SHAPIRO LLP

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NEW YORK, NY 10019

EXAMINER

LIN, JERRY

ART UNIT

PAPER NUMBER

1631

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/583,600	<b>Applicant(s)</b> TORII ET AL.	
	<b>Examiner</b> JERRY LIN	<b>Art Unit</b> 1631	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 February 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15, 17-25 and 40-53 is/are pending in the application.
- 4a) Of the above claim(s) 2, 10-15, 17, 18, 20-25, 43-45 and 47-53 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3-9, 19, 40-42 and 46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/19/06, 1/25/08</u>  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of Species B and subspecies iv (claims 1, 3-9, 19, 40, 41, 42, and 46) in the reply filed on February 12, 2010 is acknowledged. The traversal is on the ground(s) that the different species and subspecies share the same judgment result as in step (4) of claim 1. This is not found persuasive because, while claim 1 is generic to species A-C, the species do not share the same special technical feature. The Examiner acknowledges that claim 1 is generic to the species A-C, and thus the species would have all the limitations of claim 1. However, the requirement made by the Examiner is a species election. The special technical features recited by the claims in the species are not shared by the other species. Thus, the species do not share the same special technical feature.

The requirement is still deemed proper and is therefore made FINAL.

### ***Status of the Claims***

Claims 1, 3-9, 19, 40, 41, 42, and 46 are under examination.

Claims 2, 10-15, 17, 18, 20-25, 43-45, and 47-53 are withdrawn as being drawn to a non-elected species or subspecies.

### ***Claim Rejections - 35 USC § 112, 2<sup>nd</sup> Paragraph***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 3-9, 19, 40, 41, 42, and 46 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The instant claims appear to be either translated from a foreign language or utilizing language common to foreign practice. The instant claims contain passive language without clear transitional language. Thus, the instant claims are unclear. The Examiner has attempted to identify how the claims are unclear below.

Regarding claim 1, it is unclear where the preamble ends and where the method steps begin. The instant claim recites "characterized in that" in line 2, which would suggest the beginning of the body of the claims. However, lines 3-8 contain no method steps. In line 12, the instant claim describes how the mass spectrometric result is to be obtained. However, it is unclear if the steps after line 12 are intended to be active steps of the claims or if they are intended to just describe the source of the mass spectrometric result. The steps that follow line 31 are similarly confusing. In addition, it is unclear if the numbering within the claim are intended to delineate steps. The instant claims may be clarified using clear active steps. In lines 6 and 35, the term "deduced" is in parenthesis. It is unclear if this term is intended to be a limitation of the instant claim.

Instant claims 3-9 recite different "cases". It is unclear if these are different scenarios in which to apply claimed method 1 or if these are intended to further limit specific limitations within claims 1 or 3. It is also unclear if there are active steps in the instant claims.

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Instant claim 19, lines 5-20, it is unclear if these are meant to be active steps.

Instant claims 40, 41, 42, and 46 are rejected for depending from the above claims.

### ***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JERRY LIN whose telephone number is (571)272-2561. The examiner can normally be reached on 7:30-6:00pm, M-TH.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marjorie A. Moran can be reached on (571) 272-0720. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Jerry Lin/

Primary Examiner, Art Unit 1631

5/21/2010